

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

First Named Inventor: LEAH, ROBERT

Art Unit: To be assigned

Intl. Appln. No.: PCT/GB2005/000355

Examiner: To be assigned

Intl. Filing Date: 2 February 2005

U.S. Application No.: 10/588,897

Confirmation No.: 4108

For: A METHOD AND APPARATUS FOR OPERATING A SOLID-OXIDE FUEL
CELL STACK WITH A MIXED IONIC/ELECTRONIC CONDUCTING
ELECTROLYTE

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REQUEST FOR RECONSIDERATION OF DECISION
ON PETITION UNDER 37 C.F.R. § 1.181

OFFICE OF PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request favorable reconsideration of the Decision on
Petition Under 37 C.F.R. § 1.181, dated May 22, 2009.

Counsel wishes to acknowledge with appreciation the telephone conference with
Mr. Leonard Smith on or about July 15, 2009.

As was discussed during the telephone conference, and as will be explained
further below, the holding of abandonment of this application was both procedurally and
substantively erroneous. In particular, the holding of abandonment was premature,
because the Office's Decision dated January 30, 2009 erroneously held that Applicants'
period for response had expired, when, in fact, it had not. Secondly, that Decision
erroneously refused to accord this application a national stage commencement date under
35 U.S.C. § 371(c), notwithstanding the fact that Applicants' Declaration filed October

14, 2008 contained all required averments under 37 C.F.R. §§ 1.497(a) and (b). Thirdly, the application was held abandoned on grounds raised for the first time in the January 30 Decision, without Applicants having been given a proper and fair opportunity to respond.

On August 12, 2008, the Office notified Applicants, via Form 905 (Notification of Missing Requirements under 35 U.S.C. 371), that an Oath and Declaration must be submitted to the Office within two (2) months of this notification (i.e., by October 12, 2008). The Office also notified Applicants that the response period may be extended under the provisions of 37 C.F.R. 1.136(a) (e.g., up to five extensions after the October 12, 2008, deadline, thus, until **March 12, 2009**).

Applicants responded by filing an executed Declaration on October 14, 2008.

On 30 October 2008, the Office mailed Form PCT/DO/EO/916 (Notification of Defective Response), which stated that Applicants' Declaration did not comply with 37 C.F.R. §§ 1.497(a) and (b) in that it:

“... is defective in that the address of the first three inventors has been scratched through and are hand written. **These hand written addresses are illegible and hard to read.** Please resubmit oath with **clear and legible address of all inventors.**” (Emphasis added.)

Form 916 also stated that Applicants were required to respond within 1 month from the date of the notification **or within the time remaining in the response set forth in the Notification of Missing Requirements (Form 905), whichever is longer** (emphasis added). Thus, Applicants had until **March 12, 2009** to comply with this requirement based on the issue date of the Notification of Missing Requirements.

As Form 916 was best understood, Applicants' Declaration was deemed to be defective solely because the Office found the handwritten addresses “illegible and hard to

read.” No other defect was specifically alleged in Form 916. It was therefore understood that the Office was simply seeking clear and legible addresses for all inventors.

As the address information is not a requirement under 37 C.F.R. §§ 1.497(a) and (b), on November 24, 2008, Applicants replied to Form 916 by submitting a Supplemental Application Data Sheet, which was believed in good faith to be a proper form of response in accordance with the procedures provided for under 37 C.F.R. § 1.497(c) to provide inventor address information. As the address information in the Supplemental Application Data Sheet was clear and legible, Applicants believed that the Supplemental Application Data Sheet fully satisfied Form 916. Moreover, it is noted that the address information provided in the Supplemental Application Data Sheet was transcribed directly from Applicants’ Declaration, which was therefore not illegible as had been asserted in Form 916, and thus not defective for the reason asserted in Form 916.

Notwithstanding that Applicants had endeavored in good faith to comply with the Office’s requirements, and had not sought relief under 37 C.F.R. § 1.181, their response to Form 916 was treated as a Petition, and on January 30, 2009, the Office issued a Decision holding this application abandoned. Although the Decision acknowledged expressly that the inventor’s address information is not a requirement under 37 C.F.R. §§ 1.497(a) and (b), and therefore implicitly that the requirements of those provisions had been met, it nevertheless held Applicants’ Declaration to be non-compliant because the handwritten addresses had not been initialed and dated. The Decision further stated that the Applicants’ period for responding had expired and therefore held the application abandoned.

The holding of abandonment was clearly erroneous.

Firstly, Applicants' period for responding in this case had not expired. Form 916 had set a response period of one month from the date of the notification or the time remaining in the response set forth in the Notification of Missing Requirements (Form 905), whichever is longer. Thus, Applicants response period was extendable until March 12, 2009 and had not expired, and the application therefore should not have been held abandoned regardless of the propriety of Applicants' Declaration.

Moreover, the presence of non-initialed/dated alterations in Applicants' address information—information which the Office concedes is not required under 37 C.F.R. §§ 1.497(a) and (b)—cannot negate the fact that Applicants executed the averments that **are** required under those provisions. Applicants' Declaration therefore complied with 37 C.F.R. §§ 1.497(a) and (b), notwithstanding the presence of the address alterations, and the holding of abandonment was therefore erroneous on this basis as well. Applicants should have been granted a 371(c) date, and either a new Declaration or Supplemental Application Data Sheet should have been required and a new period for response set under 37 C.F.R. § 1.497(c).

Finally, Applicants respectfully note that the issue of non-initialed/dated alterations had not been raised in Form 916. Instead, it was raised **for the first time** in the January 30, 2009 Decision. Consequently, the application was held abandoned based on an issue that the Office had not previously raised and to which Applicants had not been given an opportunity to specifically address. Given that Applicants had made a good faith attempt to respond to Form 916, by addressing the defect specifically alleged therein and by following the procedure set forth in 37 C.F.R. § 1.497(c), it would certainly have been both appropriate and fair for the Office to afford Applicants an opportunity to remedy the defect **newly** asserted in the January 30 Decision, rather than

holding the application abandoned. Indeed, to have held the application abandoned based on grounds raised for the first time in the January 30 Decision is fundamentally unfair and unjust.

In the recent Decision of May 22, 2009, the Office found the new Declaration papers filed with Applicants' April 2, 2009 submission to be incomplete. Applicants sincerely regret this error. New Declaration papers are being submitted herewith.

In view of the above discussion, and the submission of proper Declaration papers herewith, it is respectfully requested that the holding of abandonment of this application be withdrawn and that this application be accorded a 371(c) date and passed for national stage examination.

Applicants believe that there are no fees due in connection with the filing of this paper. However, the Commissioner is hereby authorized to charge Deposit Account No. 50-1165 (XA-10629) any fees that may be required by this paper, and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and has not been separately requested, such extension is hereby requested.

Respectfully submitted,

Date: July 22, 2009

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